

Application No.: 09/682,562
Attorney Docket No.: TNX 00-08
Customer No.: 26839

REMARKS

Claims 1-9 are currently pending in this application. Applicant has amended claims 1-2, 5 and 8 to more particularly and distinctly claim that which Applicant regards as her invention.

Response to Rejection Under 35 U.S.C. 103(a)

The Office has rejected claims 1-9 as unpatentable over Chang (U.S. Pat. No. 5,614,611) in view of Carson et al (U.S. Pat. No. 6,610,661), the combination in view of Schwartz ((U.S. Pat. No. 6,562,798) and Idusogie et al. ((U.S. Pat. No. 6,538,124). The Office alleges that although Chang does not teach co-administration of CpG, it would have been obvious to enhance the elimination of IgE bearing B-cells by administering anti-IgE and further reduce the side-effects of IgE by administering CpG in view of Carson.

Applicant respectfully traverses this rejection. As the Office knows, in order for a *prima facie* case of obviousness to be established, the references cited must suggest the claimed invention. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Here there is no suggestion in the references cited to enhance the ADCC elimination of IgE bearing B-cells by adding CpG in combination with an anti-IgE antibody. The mere fact that it was known that anti-IgE may eliminate B-cells and that CpG could cause a TH2 to TH1 shift is not sufficient to motivate their combination without the use of Applicant's specification. This is an improper use of hindsight.

Often times, particularly with the aid of hindsight, the art appears combinable or modifiable in a manner that will yield the claimed invention. That itself will not make the resultant modification obvious, however. The art must still suggest the desirability of the modification. See *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) ("The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.");

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accord *In re Laskowski*, 871 F.2d at 117, 10 U.S.P.Q.2d at 1398; *In re Fritch*, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780, 1783-1784 (Fed. Cir. 1992) (flexible landscape edging device, although capable of conforming to a ground surface of varying slope, not suggested by combination of prior art references); see also *In re Mills*, 916 F.2d 680, 682, 16 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 1990); *Ex parte Levengood*, 28 U.S.P.Q.2d at 1302; *Gloxo Wellcome, Inc. v. Pharmadyne Corp.*, 32 F. Supp. 2d 265, 300 (DC MD 1998). The Federal Circuit noted in *Carlisle Plastics, Inc. v. Spotless Enterprises, Inc.*, 1999 U.S. App. LEXIS 937 (Fed. Cir. 1999)(unpublished) that hindsight reconstruction is particularly tempting with an invention involving simple technology. In *Carlisle*, the subject matter of the invention was hangers. In affirming that the invention was not invalid for obviousness, the Federal Circuit stated:

While the "technology" of this case is very simple, and while the elements of the invention were plainly present in the prior art references, we are not prepared to overturn the district court's ruling that Carlisle failed to satisfy its heavy burden of providing the court with clear and convincing evidence that the invention of the reexamined '902 patent would have been obvious to one of ordinary skill in the art at the time of the invention. [citation omitted] We agree with the district court that the commercial success of the embodiment of the invention and the failure of anyone (including Carlisle's predecessor) to combine the prior art elements before the inventor did so provide significant support for the conclusion that the invention was not obvious, notwithstanding that combining the elements in the prior art would seem, with the considerable benefit of hindsight, to be fairly elementary. *Id.* at *5.

See also, *In re Dembiczak*, 1999 U.S. App. LEXIS 8109, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999) in which the Federal Circuit held the claimed invention non-obvious. In *Dembiczak*, the subject matter of the patent related to garbage bags which looked like jack-o-lanterns. The Federal Circuit stated:

Our analysis begins in the text of section 103 quoted above, with the phrase "at the time the invention was made." For it is this phrase that guards against entry into the "tempting but forbidden zone of hindsight," when analyzing the patentability of claims pursuant to that section. Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease

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with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher."...Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.

Id. at *10 (citations omitted).

Applicant asserts that without the benefit of Applicant's specification, the prior art references cited do not suggest the claimed invention and thus the Office has not met its burden of establishing a *prima facie* case of obviousness.

In view of the foregoing Applicant asserts that the rejection should be withdrawn.

In view of the amended claims and the rebuttal of the rejection of obviousness, Applicant asserts that the claims are in condition for Allowance and requests a timely notice allowing these claims.

Respectfully Submitted,

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